REMARKS

This Amendment is submitted in response to the Office Action dated August 19, 2003, having a shortened statutory period set to expire November 19, 2003. Claims 1-2 and 4-15 are pending. Claims 1, 6, and 11 are independent claims. Applicants have amended Claims 1, 6, and 11. No new matter has been entered by these amendments.

Claim Rejections -- 35 U.S.C. § 103

In section 4 of the present Office Action, claims 1-2, 4-7, 9-12, and 14-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,336,124 B1 to *Alam* et al. ("*Alam*"), issued January 1, 2002, filed July 7, 1999 in view of U.S. Patent Number 5, 813,020 to *Hohensee* et al. ("*Hohensee*"), issued September 22, 1998, U.S. Patent Number 5,767,833 to *Vanderwiele* et al. ("*Vanderwiele*"), issued June 16, 1998, and U.S. Patent Number 6,590,674 B1 to *Orton*, issued July 8, 2003, filed September 23, 1999. This rejection is respectfully traversed and reconsideration of the claims is respectfully requested.

With respect to exemplary claim 1, therein is recited the step of:

> *for each unit, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing;*

Neither *Orton*, *Vanderwiele*, *Alam*, nor *Hohensee* show or suggest this element of exemplary claim 1. While it is argued on page 4 of the present Office Action that performing such a comparison results in advantages when the units are subsequently stored in accordance with the comparison (the step of "comparing"), Applicant's submit that nothing within the prior art suggests making such a comparison. Given the failure of the prior art to show or suggest this element of exemplary claim 1, Applicants respectfully submit that the present invention as claimed in exemplary claim 1, and further similarly as claimed in the remaining pending claims, is patentable over the prior art, and the rejection under Section 103 should be withdrawn.

Exemplary claim 1 further recites the steps of:

storing said units, requiring less than said predetermined level of data processing to convert to device-dependent format, in device-independent format; storing said units, requiring more than said predetermined level of data processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices;

Applicant's submit that nothing within the prior art suggests storing the units based on whether the level of processing required to convert to a device-dependent format exceeds a threshold as determined by the comparison. On page 4 of the present Office Action, it is argued that storing "units" in device-independent or device-dependent format, depending upon a comparison of the amount of data processing required to convert the unit to a device-dependent format, would have been obvious to one of ordinary skill in the art at the time of the invention. The *Orton* and *Vanderwiele* references cited storing units in dependent and independent formats, respectively, without considering whether storing in such a format is proper in light of the speed of delivering data or the level of processing required. While the Examiner appears to recognize that the prior art does not show or suggest making such a comparison before determining the type of format to be used in storing the data, the Examiner nonetheless argues in the present Office Action that such a method would be obvious based on the benefits presented by the present invention. Applicants respectfully submit that such an analysis concludes that the present invention is obvious in hindsight of the present invention.

Last, the Examiner has failed to present a *prima facie* case of obviousness for the pending claims. In particular, the Final Rejection fails to explain how any of the claim elements of:

for each unit, comparing an amount of data processing required to convert said unit to device-dependent format to a predetermined level of data processing; storing said units, requiring less than said predetermined level of data processing to convert to device-dependent format, in device-independent format; storing said units, requiring more than said predetermined level of data processing to convert to device-dependent format, in device-dependent format based on the classified plurality of presentation devices;

are taught or suggested by the prior art. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2142-2143.

Since the references do not suggest "storing" in conformance with the claims, the Examiner has argued that someone of ordinary skill would find the advantages of the present invention as obvious, and then working backward by arguing that, since the invention is useful, it must have been obvious. Defining the motivation or suggestion to modify the prior to arrive at the present invention in terms of its advantages reveals improper hindsight in the selection of the prior art relevant to obviousness. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial & Trading Co., Ltd.*, 139 F.3d 977, 45 USPQ2d 1977 (Fed. Cir. 1998). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)).

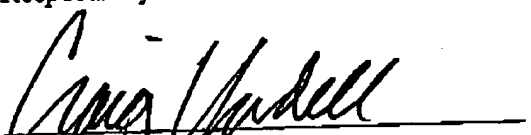
The Examiner presents as "evidence" a bare assertion that the logical process of determining whether to store units in dependent or independent formats is obvious without citing a single reference that performs or suggests making such a comparison before storing units. "However, the test of whether it would have been obvious to select specific teachings and combine them as did the Applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." *In re Dance*, 160 F.3d 1339, 48 USPQ2d 1635 (Fed. Cir. 1998). The Examiner's evidence of obviousness is created from broad conclusory statements about the knowledge of those of ordinary skill in the art without any

objective evidence of a suggestion for making the comparison and then storing the units accordingly, as performed in exemplary claim 1 in the present application. Again, Applicants respectfully submit that such a rejection is improper. "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ADT Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). *Crown Operations International, Ltd. V. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

In summary, Applicants submit that the prior art of record does not show or suggest comparing the processing power required to convert a unit of an object within a document to a device dependent format in order to determine whether it should be stored in device-dependent or device-independent format is not shown or suggested in the prior art and that the rejection under Section 103 should be withdrawn. Further, Applicants respectfully submit that there is no motivation or suggestion in the prior art to make the combination of steps, means, and instructions as recited in independent claims 1, 6, and 11 and that the Examiner has derived such suggestion in hindsight of the present invention.

For the reasons given above, Applicants respectfully request reconsideration of the claims and submit that the application is now in condition for allowance.

Respectfully submitted,



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